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**APR 29 2005**

**OFFICE OF PETITIONS**

In re Application of

Last

Application No. 09/829,802

Filing Date: 10 April, 2001

Attorney Docket No. (None)

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DECISION

This is a decision on the petition filed on 24 March, 2003, resubmitted on 1 March, 2005, and supplemented on 28 March, 2005, alleging unavoidable delay under 37 C.F.R. §1.137(a), and, in light of the allegations considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **GRANTED**, and the petition under 37 C.F.R. §1.137(a) is **DISMISSED as moot**.

**BACKGROUND**

The record reflects that:

- following an 11 January, 2002, Restriction requirement and a 22 March, 2002, Election (with request and fee for extension of time) Petitioner failed to reply timely and properly to a "Notice of Nonresponsive Amendment" mailed on 7 May, 2002, with reply due absent extension of time on or before 7 June, 2002;
- the application went abandoned after midnight 7 June, 2002;
- Petitioner first filed the instant petition (with fee, supporting documents and a clean and marked-up version of the amendment as the reply) under 37 C.F.R. §1.137(a) on 24

March, 2003, however, it appears that, while the petition and supporting documents were matched with the file, the file was not forwarded to the Office of Petitions for consideration until this writing;

- the Office did not mail the Notice of Abandonment until 9 December, 2004;
- on 1 March, 2005, Petitioner resubmitted the instant petition, with fee, and a clean and marked-up version of the amendment as the reply, and on 28 March, 2005, Petitioner supplemented his petition with copies of his office records (e.g., docket sheets) and declarations.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

Allegations as to the Request to  
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>7</sup>

Petitioner evidences non-receipt of the Notice of Nonresponsive Amendment.

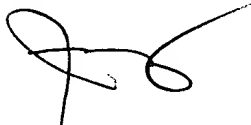
**In matters such as these in which Petitioner observes that the Office has not responded to Petitioner's filing(s), Petitioner may find it of particular value (to demonstrate/evidence at a later date Petitioner's diligence in attention to such matters) to calendar a Status Inquiry at six- (6-) month intervals.**

CONCLUSION

Because Petitioner satisfied the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 hereby is **granted**, and the 9 December, 2004, Notice of Abandonment hereby is vacated; the petition under 37 C.F.R. §1.137(a) is **dismissed as moot**, and the petition fee (\$55.00) is waived and it appears none was charged.

The instant application is forwarded to Technology Center 3700 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).